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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/339,634	06/24/1999	SCOTT C. COTTRILLE	777.204US1	2835
26389	7590	09/22/2004	EXAMINER	
CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347			YUAN, ALMARI ROMERO	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/339,634

Applicant(s)

COTTRILLE ET AL.

Examiner

Almari Yuan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Request for Reconsideration filed 4/15/04.
2. Claims 1-19 are pending in the case. Claims 1, 7, and 16 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over van Hoff (USPN 5,822,539 - filed on 12/1995) in view of "Scope of the Annotation Protocol", 12/1995, <<http://www.hypernews.org/~liberte/www/annotation-protocol-design>> , pages 1-3 (herein after "Annotation Protocol").**

Regarding independent claim 7, van Hoff discloses:

A scalable method of retrieving an annotation associated with a content source, the method comprising:

 sending a document identifier associated with a content source to a tier I server, said tier I sever being part of a multiple tier hierarchal annotation server system that also includes a tier II server (van Hoff on col. 5, lines 1-32 and col. 6, lines 34-57, see figure 2: teaches annotation with a unique identifier to retrieve requesting document; annotations are retrieved from an annotation proxy (tier server I) and document retrieved from a web server (tier server II)); and

if an annotation is associated with the document identifier, receiving a reference from said tier I server to said tier II server, said tier II server maintaining additional information regarding the annotation associated with the document identifier (van Hoff on col. 5, lines 1-32, col. 6, lines 34-57 and lines 65-67, see figure 2: teaches the annotation proxy server (tier I) receives the client requests, each annotations are uniquely identified to be associated with requesting document which can be located and retrieved from a web server (tier server II); each document is identifiable by a unique document identifier to identify document stored in server 104; the proxy server applies the identified annotation directory to the received document to add annotation).

However, van Hoff does not explicitly disclose "tier I server storing minimal information regarding annotations associated with said content source, said minimal information including the existence of annotations associated with said content source and the identification of said tier II server if said annotations exist".

Annotation Protocol discloses an annotation server may serve annotations for several distinct sets of URLs; subsets and supersets may be on different servers (on page 2, 1st paragraph); the annotation servers should be able to offer information to clients about all the URLs that have annotations or may have annotations so that clients using a scalable lookup of annotations (on page 2, 4th paragraph).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Annotation Protocol into van Hoff to provide sets of URLs on different servers and determining if annotation exist using a scalable lookup of annotations, as taught by Annotation Protocol, incorporated into the multiple server environment, as taught by

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van Hoff, in order for the user to avoid making requests to the server that has no annotations in the set.

5. **Claims 1-6 and 8-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over van Hoff (USPN 5,822,539 - filed on 12/1995) in view of Van Der Meer (USPN 6,289,362 B1 - filed on 9/1998), and in further view of “Scope of the Annotation Protocol”, 12/1995, <<http://www.hypernews.org/~liberte/www/annotation-protocol-design>> , pages 1-3 (herein after “Annotation Protocol”).**

Regarding independent claim 1, van Hoff discloses:

A scalable method of storing an annotation associated with a content source, the method comprising:

representing an annotation having a plurality of properties wherein one of the plurality of properties is a document identifier (van Hoff on col. 5, lines 1-32: teaches annotation having a unique identifier);

the document identifier identifying the content source with which the annotation is associated (van Hoff on col. 5, lines 1-32 and col. 6, lines 34-57, see figure 2: teaches associating annotation with requesting document; annotations are retrieved from an annotation proxy server);

storing the annotation on the servers of a multiple tier hierarchical annotation server system wherein the information about the annotation but not the annotation is stored on a lower tier server and the annotation is stored on a higher tier server (van Hoff on col. 3, lines 4-21, col. 6, line 65 – col. 7, line 1, and col. 8, line 64 – col. 9, line 2, see figure 2: teaches annotations stored

in the annotation proxy server; wherein the documents associated with stored annotations are stored in the web server to be retrieved. In figure 2, shows the multiple tier network system comprising the web client 102, annotation proxy server 118, 119, and web servers 104a, 104b, and 104c; not shown but discloses on col. 5, lines 24-26, the requested document and any cross-referenced document can be on the same or different servers 104, at any web sites anywhere).

However, van Hoff does not explicitly disclose, "annotation as an object".

Van Der Meer on col. 2, lines 44-52: teaches object including annotation.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Van Der Meer into van Hoff to provide an object including annotation incorporated to the annotation associated with a document and retrieved from a server which will advantageously enable the content provider (server) to maintain a control of objects (annotations) displayed to the user.

However, van Hoff and Van Der Meer do not explicitly disclose "storing the annotation and information about the annotation accessible using the document identifier".

Annotation Protocol discloses an annotation server may serve annotations for several distinct sets of URLs; subsets and supersets may be on different servers (on page 2, 1st paragraph); annotation server stores annotations (on page 2, 3rd paragraph); attributes of an annotation will be given a URL (on page 2, 5th paragraph).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Annotation Protocol into van Hoff and Van Der Meer, to provide an annotation server for storing annotations and attributes of an annotation is given a URL, as taught by Annotation Protocol, incorporated into the multiple server environment, as

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taught by van Hoff and Van Der Meer, in order to facilitate the creation and retrieval of annotations.

Regarding dependent claim 2, Van Der Meer discloses:

wherein the act of representing the annotation as an object having a plurality of properties further comprises defining generic properties of the annotation (Van Der Meer on col. 11, lines 25-32: teaches define annotation e.g. link data, expiration data, etc.).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Van Der Meer into van Hoff to provide an object including annotation incorporated to the annotation associated with a document and retrieved from a server which will advantageously enable the content provider (server) to maintain a control of objects (annotations) displayed to the user.

Regarding dependent claim 3, Van Der Meer discloses:

wherein the generic properties are selected from the group consisting of type, content, author name, creation time, modify time, time to-live, document identifier, index and parent identifier (Van Der Meer on col. 11, lines 25-32: teaches define annotation e.g. link data, expiration data, etc., (which may include creation time, modify time, etc.)).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Van Der Meer into van Hoff to provide an object including annotation incorporated to the annotation associated with a document and retrieved from a server which will advantageously enable the content provider (server) to maintain a control of objects (annotations) displayed to the user.

Regarding dependent claim 4, Van Der Meer discloses:

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wherein the type property of the annotation is selected from the group consisting of: a text file, a threaded message, an audio file, a video file, a calendar file, and a chat (Van Der Meer on 4, lines 37-60: teaches objects as cartoon characters, company advertisements, etc.).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Van Der Meer into van Hoff to provide an object including annotation incorporated to the annotation associated with a document and retrieved from a server which will advantageously enable the content provider (server) to maintain a control of objects (annotations) displayed to the user.

Regarding dependent claim 5, van Hoff discloses:

wherein the act of representing the annotation as a object having a plurality of properties further comprises define one or more type specific properties unique to the type property of the annotation (van Hoff on col. 5, lines 1-32: teaches annotations having a unique identifiers) and (Van Der Meer on col. 11, lines 25-32: teaches define annotation e.g. link data, expiration data, etc. (different types of properties).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Van Der Meer into van Hoff to provide an object including annotation incorporated to the annotation associated with a document and retrieved from a server which will advantageously enable the content provider (server) to maintain a control of objects (annotations) displayed to the user.

Regarding dependent claim 6, van Hoff discloses:

wherein the document identifier is selected from the group consisting of: a file name, a directory path, and a uniform resource locator (van Hoff on col. 2, lines 1-26: teaches unique identifier as an URL).

Regarding dependent claims 8 and 9, van Hoff discloses:

displaying the first response in a manner that is non-intrusive or intrusive to the content source (van Hoff on col. 3, lines 17-21: teaches annotation proxy server similar to a firewall proxy (to filter non-intrusive or intrusive requested documents)).

Regarding dependent claim 10, van Hoff discloses:

sending a request to the tier II server for additional information regarding the annotation associated with the content source; and receiving a response from the tier II server, said response comprising at least property of the annotation (van Hoff on col. 5, lines 1-32 and col. 6, lines 34-57, see figure 2: teaches the web server (tier II server) containing requested documents or other information to be associated with annotations retrieved from an annotation proxy server), storing the annotation associated with the document identifier (van Hoff on col. 5, lines 1-32, col. 6, lines 34-57 and lines 65-67, see figure 2: teaches each document is identifiable by a unique document identifier to identify document stored in server 104; the proxy server applies the identified annotation directory to the received document to add annotation, in other words, the annotation is associated with the document based on its unique document identifier).

However, van Hoff does not explicitly disclose, "reference to a tier III server".

Van Der Meer on col. 4, lines 37-60: teaches a presentation context server (not shown in figure 1) (as tier III server) in communication with the diary server (tier II sever).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Van Der Meer into van Hoff to provide a presentation context server (not shown in figure 1) (as tier III server) incorporated as a different type of server in communication with the web server (tier II) containing documents and other information to be associated with annotations which will enhance the presentation of data by controlling the data displayed to the user.

Regarding dependent claims 11 and 12, van Hoff discloses:

further comprising displaying the at least one property of the annotation in a manner that is non-intrusive or intrusive to the content source (van Hoff on col. 3, lines 17-21: teaches annotation proxy server similar to a firewall proxy (to filter non-intrusive or intrusive requested documents)).

Regarding dependent claim 13, Van Der Meer discloses:

sending to tier III server an annotation identifier for the annotation associated with the content source; and receiving a third response from the tier III server, wherein the third response comprises the annotation identified by the annotation identifier annotation (Van Der Meer on col. 4, lines 9-60: teaches a presentation context server (not shown in figure 1) (as tier III server) in communication with the diary server (tier II sever) to retrieve template associated with the object including annotation).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Van Der Meer into van Hoff to provide a presentation context server (not shown in figure 1) (as tier III server) incorporated as a different type of server in communication with the web server (tier II) containing documents and other information to be

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associated with annotations which will enhance the presentation of data by controlling the data displayed to the user.

Regarding dependent claims 14 and 15, van Hoff discloses:

further comprising displaying the annotation identified by the annotation identifier in a manner that is non-intrusive or intrusive to the content source (van Hoff on col. 3, lines 17-21: teaches annotation proxy server similar to a firewall proxy (to filter non-intrusive or intrusive requested documents)).

Regarding claims 16-19, the limitations of claims 16-19 are a computer readable medium for processing the method of claims 1-6 and 8-15 and are rejected under the same rationale.

Response to Arguments

6. Applicant's arguments filed 4/15/04 have been fully considered but they are not persuasive.

Regarding Applicant's remarks on pages 3-5:

Applicant argues that Van Hoff does not teach "receiving a reference from said tier I server to said tier II server, said tier II server maintaining additional information regarding the annotation associated with the document identifier".

Van Hoff on col. 5, lines 1-32, col. 6, lines 34-57 and lines 65-67, see figure 2 teaches the annotation proxy server (tier I) receives the client requests, each annotations are uniquely identified to be associated with requesting document which can be located and retrieved from a web server (tier server II). Furthermore, Van Hoff on col. 4, lines 32-37 teaches the information

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server receives instructions to forward the requested document to the proxy server. In other embodiments of van Hoff's system, the annotation proxy server 118 is resident on the web information server which provided the requested document, the annotation and merging of the original document with the annotations to generate a hypertext link annotated document may occur prior to transmission of the document to the client 102 (see col. 9, lines 21-33, in other words, web information server will have the capability in processing annotations for the client.

Applicant argues that the publication Annotation Protocol does not disclose "tier I server storing minimal information regarding annotations associated with said content source, said minimal information including the existence of annotations associated with said content source and the identification of said tier II server if said annotations exist".

Annotation Protocol on page 2 teaches an annotation server may serve annotations for several distinct sets of URLs and may not know all the annotation sets it serves. Then annotations set may contain several annotations subsets and supersets that may be on different servers. Furthermore, a scalable lookup of annotations can be offered to the clients will all the URLs that have annotations in order for the clients to avoid making requests to a server that probably has no annotations.

Regarding Applicant's remarks on pages 6-7:

Applicant argues that van Hoff does not teach "storing the annotation on the servers of a multiple tier hierarchical annotation server system wherein the information about the annotation but not the annotation is stored on a lower tier server and the annotation is stored on a higher tier server".

van Hoff on col. 3, lines 4-21, col. 6, line 65 – col. 7, line 1, and col. 8, line 64 – col. 9, line 2, see figure 2 teaches annotations stored in the annotation proxy server in a hierarchical computer network shown in Figure 2; wherein the documents associated with stored annotations are stored in the web server to be retrieved. Furthermore, Van Hoff on col. 4, lines 32-37 teaches the client sends instructions to the information server; the information server receives the instructions to forward the requested document to the proxy server. Van Hoff's annotation proxy server can be resident on the web information server; wherein the web information server will the capability of processing information about the requesting annotations to be merged to its stored requested document (see col. 9, lines 21-33).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Almari Yuan whose telephone number is 703-305-5945 (571-272-4104 after October 20, 2004). The examiner can normally be reached on Mondays - Fridays (8:30am - 5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild, can be reached on 703-305-9792 (571-272-4090 after October 20, 2004). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AY
September 17, 2004



JOSEPH FEILD
SUPERVISORY PATENT EXAMINER